

### **REMARKS**

Applicant wishes to thank the Examiner for the consideration given this case to date. Applicant has now had an opportunity to carefully consider the Examiner's action, and respectfully submits that the application, as amended, is now in condition for allowance. Currently, claims 1-8 and 13-15 are pending.

Initially, it is respectfully submitted that the Office has incorrectly entered Applicant's name as Roger E. Marohart. The Applicant's correct name is Roger E. Marchant, as identified in the previously filed Request for Corrected Filing Receipt dated June 1, 1999 and received by OIPE on June 7, 1999. Correction of Applicant's name is respectfully requested.

### **THE EXAMINER'S ACTION**

In the Office Action dated March 21, 2003, the Examiner:

withdrew claims 9-12 and 16-20 as being drawn to a nonelected subject matter;  
objected to the specification and claims for failing to adhere to the sequence rules;

rejected claims 1 and 13 under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, was in possession of the claimed invention;

rejected claims 1 and 13 under 35 U.S.C. 112, second paragraph as being indefinite; and

rejected claims 1 and 13 under 35 U.S.C. § 103 as being obvious in light of Qui in view of Drumheller.

### **SPECIFICATION AND CLAIM OBJECTIONS**

The specification and claims have been amended to correctly designate each of the identified peptides by the appropriate SEQ ID No. As such, the objection is believed to have been overcome.

#### **REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH**

The Office asserts that the "combinations thereof" as recited in claim 1 and 13 is not defined in the specification. Applicant respectfully submits that the claims as filed in the original specification are part of the disclosure, thus Applicant has described the subject matter in such a way to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, was in possession of the claimed invention. MPEP 2163.06.

In addition, Applicant has provided examples of surfactants exhibiting a combination of linkages. Specifically, in Examples 9 and 10, the peptide and hexanal are attached by secondary amine linkages and the dextran lactone or maltolactone are attached by amide linkages (see Spec. page 21, lines 20-30, page 22, lines 1-4). Moreover, Applicant discloses that the polymeric backbone contains a combination of functional side groups, including OH, COOH and NH<sub>2</sub>, which inherently gives rise to amine and amide linkages (see Spec. page 4, lines 25-20). Given the teaching of the present application, one of ordinary skill in the art could readily identify hydrophilic and hydrophobic side chains attached to a polymeric backbone by amide, amine and ester linkages, as well as a combination of such linkages. As such, Applicant has adequately described hydrophobic and hydrophilic side chains linked to a polymeric backbone by combinations of amide, amine or ester linkages as contemplated in the amended claims, and therefore the rejection should be withdrawn.

#### **REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

In light of the foregoing, it is respectfully submitted that the claims particularly point out and distinctly claim the subject matter which applicant regards as the invention, and therefore this rejection should likewise be withdrawn.

#### **REJECTIONS UNDER 35 U.S.C. § 103(a)**

The Office has rejected claims 1 and 13 under §103(a) as being unpatentable over Qui in view of Drumheller. The Office has taken the position that it would have been obvious to add the peptide disclosed in Drumheller to the surfactant polymer of Qui in order to enhance the adhesive and nonadhesive interactions. (Office Action page 6).

It is respectfully submitted that the Office has improperly identified the Qui reference as prior art. If an application is entitled to priority under 35 U.S.C. 119(e) from a provisional application, the effective filing date of a U.S. application is the filing date of the provisional application. MPEP § 706.02. The present application, filed on April 29, 1999, claims priority back to U.S. Provisional Application No. 60/083,544, filed on April 29, 1998. Therefore, the effective filing date of the present application is April 29, 1998. MPEP § 706.02 Applicant respectfully points out that Applicant is an author of the Qui article. If one discloses his or her own work more than 1 year before the effective filing date of the patent application, that person is barred from obtaining a patent. MPEP § 2133. Applicant's own reference was published January 13, 1998, therefore the reference was not available to the public more than one year prior to the effective filing date of the present application. As such, the Qui reference may not be cited as prior art for the instant application and the rejection under 35 U.S.C. § 103 has been overcome.

Moreover, the teachings of Drumheller alone do not render the present claims obvious to one of ordinary skill in the art. To be sure, the Office characterized Drumheller as teaching only a peptide, asserting that it would have been "obvious to one of ordinary skill in the art at the time the invention was made to have added the peptide of Drumheller to the surfactant polymer of Qui...." (Office Action page 6). The teaching of a peptide clearly does not render the present claims obvious and therefore the rejection under 35 U.S.C. § 103 has been overcome.

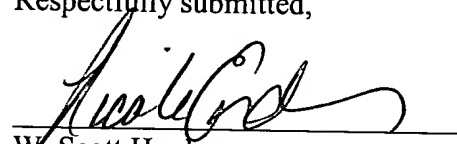
**CONCLUSION**

For the foregoing reasons, Applicant respectfully asserts that the case is now in a condition for allowance. The Commissioner is hereby authorized to charge any additional fees, or credit any overpayment to Deposit Account No. 02-2051, referencing Attorney Docket No. 26526-5.

Respectfully submitted,

Dated: June 19, 2003

By:

  
W. Scott Harders  
Registration No. 42,629

N. Nicole Endejann  
Registration No. 50,229

BENESCH, FRIEDLANDER,  
COPLAN & ARONOFF, LLP  
2300 BP Tower  
200 Public Square  
Cleveland, OH 44114-2378  
(216) 363-4443